

Docket No.

REI-10030

Declaration and Power of Attorney For Patent Application

English Language Declaration

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

ANTICONVULSANT ENANTIOMERIC AMINO ACID DERIVATIVE

the specification of which

(check one)

☐ is attached hereto.

☒ was filed on March 17, 1997 as United States Application No. or PCT International Application Number 08/818,688

and was amended on _____

(if applicable)

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d) or Section 365(b) of any foreign application(s) for patent or inventor's certificate, or Section 365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate or PCT International application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)

Priority Not Claimed

(Number)

(Country)

(Day/Month/Year Filed)

☐

(Number)

(Country)

(Day/Month/Year Filed)

☐

(Number)

(Country)

(Day/Month/Year Filed)

☐

I hereby claim the benefit under 35 U.S.C. Section 119(e) of any United States provisional application(s) listed below:

60\013,522

March 15, 1996

(Application Serial No.)

(Filing Date)

(Application Serial No.)

(Filing Date)

(Application Serial No.)

(Filing Date)

I hereby claim the benefit under 35 U. S. C. Section 120 of any United States application(s), or Section 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. Section 112, I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, C. F. R., Section 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application:

(Application Serial No.)

(Filing Date)

(Status)
(patented, pending, abandoned)

(Application Serial No.)

(Filing Date)

(Status)
(patented, pending, abandoned)

(Application Serial No.)

(Filing Date)

(Status)
(patented, pending, abandoned)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith: *(list name and registration number)*

Frank S. DiGiglio; Reg. No. 31,346

Leopold Presser; Reg. No. 19,827

William C. Roch; Reg. No. 24,972

Kenneth L. King; Reg. No. 24,223

Edward W. Grolz; Reg. No. 33,705

Paul J. Esatto, Jr.; Reg. No. 30,749

John S. Sensny; Reg. No. 28,757

Mark J. Cohen; Reg. No. 32,211

Richard L. Catania; Reg. No. 32,608

Steven Fischman Reg. No. 34,594

Send Correspondence to: Leopold Presser
Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530

Direct Telephone Calls to: *(name and telephone number)*
Leopold Presser (516) 742-4343

Full name of sole or first inventor

Harold Kohn

Sole or first inventor's signature

Harold Kohn

Date

January 7, 2002

Residence

Chapel Hill, NC 27514

Citizenship

United States

Post Office Address

705 Wellington Drive

Chapel Hill, NC 27514

Full name of second inventor, if any

Second inventor's signature

Date

Residence

Citizenship

Post Office Address

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Harold Kohn

Examiner: S. Kumar

Serial No.: 08/818,688

Art Unit: 1209

Filed: March 17, 1997

Docket: REI-10030

Reissue of Patent No.: 5,773,475

Issued: June 30, 1998

For: ANTICONVULSANT ENANTIOMERIC
AMINO ACID DERIVATIVES

Assistant Commissioner for Patents
Washington, DC 20231

DECLARATION IN SUPPORT OF REISSUE
DECLARATION UNDER 37 C.F.R. §1.175

Sir:

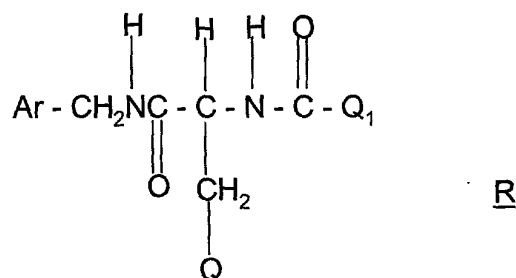
I, Harold Kohn, declare and state as follows:

1. I am a citizen of the United States, with my post office address and citizenship being stated hereinbelow next to my name. I have moved since the filing of the underlying application that matured into U.S. Patent No. 5,773,475.
2. I am the sole inventor of the subject matter which is described and claimed in U.S. Patent No. 5,773,475 ('475 patent) and described and claimed in the above-identified reissue application.
3. I do not believe that the subject matter described and claimed in the '475 patent or the reissue application was ever known or used in the United States before my invention thereof.

4. I believe that I am the original and first inventor of the subject matter which is claimed in the '475 patent and in the above-identified reissue application, for which a reissue patent is sought.

5. I have reviewed and understand the contents of the specification and claims of the '475 patent and the specification and claims of the above-identified reissue application.

6. The '475 patent is directed, in part, to a compound in the R configuration having the formula:



wherein

Ar is phenyl which is unsubstituted or substituted with at least one halo group;

Q is lower alkoxy; and

Q₁ is methyl.

It is also directed, in part, to a method of treating central nervous system disorders in an animal comprising administering to said animal in need thereof an anti-convulsant effective amount of said compound.

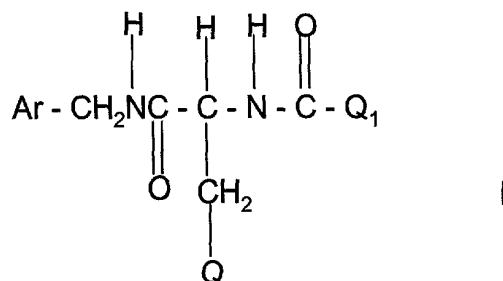
7. I believe that the '475 patent is partly inoperative by reason of the patentee claiming less than the patentee had the right to claim in the patent.

8. All errors which are being corrected in the present reissue application up to the filing of this Declaration arose without any deceptive intention on my part.

9. The error being corrected is the perfection of the claim of priority for a provisional application in which the claim of priority was made during the pendency of the underlying application for the '475 patent.

10. Attached hereto as Exhibit A is a true and accurate copy of the provisional application that was filed on March 15, 1996. It was given Serial Number U.S.S.N. 60/013,522.

11. It was directed, among other things, to a compound in the R configuration having the formula



wherein

Ar is phenyl which is unsubstituted or substituted with at least one halo group;

Q is a lower alkoxy; and

Q₁ is methyl.

The application was also directed, among other things, to a method of treating central nervous system disorders in an animal which comprises administering to said animal in need thereof an anti-convulsant effective amount of the compound of Formula I.

12. The subject matter in Paragraph 11 is described and claimed in the '475 patent.

13. An application based on the subject matter of the provisional application was filed in the United States Patent and Trademark Office on March 17, 1997, and it was assigned Serial No. U.S.S.N. 818,688.

14. Upon information and belief, March 15, 1997 was a Saturday, and the first business day after the anniversary date of the filing of the provisional application was March 17, 1997.

15. The application as originally filed containing the following sentence:

“This application claims priority from U.S. Provisional Application No. 60/013,522, filed March 15, 1996.” A true and accurate copy of the first page of the U.S.S.N. 818,688 is attached hereto as Exhibit B.

16. As further evidence that a statement containing the reference to the earlier filed application was provided in the application that was originally filed, enclosed is a copy of the original filing receipt attached hereto as Exhibit C wherein it is printed thereon that the present application is claiming priority of provisional application No. 60/013,522.

17. Upon information and belief, it is my understanding of the American Inventors Protection Act, which was recently passed, that if the anniversary date of the filing of the provisional application falls on a Saturday, Sunday or Federal Holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

18. Upon information and belief, it is also my understanding that this provision is applicable to any application that was filed on or after June 8, 1995, with the exception of a patent which is the subject of litigation in an action commenced before November 29, 1999.

19. The filing of the underlying application for the '475 patent is subsequent to June 8, 1995.

20. Although U.S. Patent No. 5,773,475 has issued, the specific reference to the earlier filed application was submitted during the pendency of the above-identified application.

21. Accordingly, I hereby claim priority under 35 U.S.C. §119(e) of U.S.S.N. 60/013,522 filed on March 15, 1996.

22. Attached hereto as Exhibit D is a Declaration for the above-identified application in which the claim of priority to the provisional application is included.

23. I acknowledge the duty to disclose information which is material to the examination of this application in accordance with 37 C.F.R. §1.56.

24. I hereby appoint the following attorneys and/or agents to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith: Leopold Presser, Reg. No. 19,827; William C. Roch, Reg. No. 24,972; Kenneth L. King, Reg. No. 24,223; Frank S. DiGiglio, Reg. No. 31,346; Paul J. Esatto, Jr., Reg. No. 30,749; John S. Sensny, Reg. No. 28,757; Mark J. Cohen, Reg. No. 32,211; Richard L. Catania, Reg. No. 32,608, Edward Grolz, Reg. No. 33,705 and Steve Fischman, Reg. No. 34,594.

Address all telephone calls to: Leopold Presser
at telephone number (516) 742-4343

Address all correspondence to: Leopold Presser, Esq.
Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

25. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further

Figure 1 consists of 12 histograms arranged in two rows of six. The top row is labeled '1000' and the bottom row is labeled '10000'. Each histogram shows the frequency of the number of non-zero elements in the vector of the first 1000 iterations. The x-axis for all histograms is 'Number of non-zero elements' ranging from 0 to 1000. The y-axis is 'Frequency' ranging from 0 to 100. The distributions are roughly bell-shaped and centered around 500.

Citizenship: United States
Residence: Chapel Hill, NC
Post Office Address: 705 Wellington Drive
Chapel Hill, NC 27514

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Harold Kohn

Examiner: S. Kumar

Serial No.: 08/818,688

Art Unit: 1209

Filed: March 17, 1997

Docket: REI-10030

Reissue of Patent No.: 5,773,475

Issued: June 30, 1998

For: ANTICONVULSANT ENANTIOMERIC
AMINO ACID DERIVATIVES

Assistant Commissioner for Patents
Washington, DC 20231

ASSENT OF ASSIGNEE TO REISSUE
APPLICATION AND OFFER TO SURRENDER PATENT

Sir:

Research Corporation Technologies, Inc. (hereinafter Assignee), the assignee of the entire interest in U.S. Patent No. 5,773,475 hereby assents to the filing of the above-identified reissue of said patent.

Further assignee hereby offers to surrender said patent in the reissue thereof. As permitted by 37 C.F.R. §1.178, the original of said patent will be submitted in due course upon indication that the application to reissue said patent will be allowed.

Pursuant to 37 C.F.R. §3.73(b), the Assignee's ownership is established by virtue of an Assignment by the inventor, Harold Kohn, to the Assignee, of his entire interest in the patent, which assignment was recorded in the U.S. Patent and Trademark Office on May 22,

1997 at Reel 8538, Frame 0093. Submitted herewith are a copy of said assignment and a copy of the Notice of Recordation of that Assignment.

Respectfully submitted,

Research Corporation Technologies, Inc.

By:


Gary M. Munsinger, Ph.D.

Title: President

Date:

January 18, 2002

RECEIVED

ASSIGNMENT OF PATENT APPLICATION

"INVENTOR(S)" means Harold Kohn

"INVENTION" means ANTICONVULSANT ENANTIOMERIC AMINO ACID DERIVATIVES

"APPLICATION" means the U.S. Patent Application covering the INVENTION, filed along with this Assignment or designated as U.S. Serial Number 08/818,688, filed March 17, 1997

"INSTITUTION" means University of Houston, Houston, TX 77204-5641

"RCT" means Research Corporation Technologies, Inc., a Delaware corporation at 101 North Wilmet Road, Suite 600, Tucson, Arizona 85711-3335.

1. The INVENTOR(S) made the INVENTION. Each INVENTOR is obligated to assign his or her rights, title and interest in the INVENTION and APPLICATION to the INSTITUTION or its designee.

2. RCT and the INSTITUTION are parties to an agreement under which RCT has evaluated and is now attempting to commercialize the INVENTION. As provided in that agreement, RCT is obligated to pay to INSTITUTION a share of the revenues generated by the INVENTION.

3. In furtherance of his or her obligations to the INSTITUTION, and the INSTITUTION's obligations to RCT, each INVENTOR wishes to assign his or her rights, title and interest in the INVENTION and APPLICATION directly to RCT.

4. Each INVENTOR hereby assigns to RCT his or her entire right, title and interest in:

- (a) the INVENTION;
- (b) the APPLICATION, all foreign applications and all divisional and continuation, in whole and in part, applications based on the APPLICATION;
- (c) all patents resulting from the APPLICATION and applications described in (b); and
- (d) all reissues, extensions, renewals and reexaminations of the patents described in (c).

5. This assignment shall allow RCT to file the applications described in paragraph 4 in its own name (but naming the INVENTORS as the inventors) in all countries of the world (where it is permissible) and the right to claim the benefit of the priority right provided by the International Convention of 1883, as amended.

INVENTOR(S) TO RCT-APPLICATION

10030

6. Each INVENTOR hereby authorizes and requests the Commissioner of Patents and Trademarks of the United States of America to issue to RCT all U.S. patents described in paragraph 4 that may be granted.

7. Each INVENTOR agrees for himself or herself and his or her heirs, executors and administrators to execute any further lawful documents that RCT might consider necessary to fully protect RCT's interest in the INVENTION and the documents described in paragraph 4.

8. Each INVENTOR covenants that he or she has not granted any right or license to make, use or sell the INVENTION to anyone, provided however, the Government of the United States of America may have rights in the INVENTION and APPLICATION by reason of sponsorship of research leading to the making of the INVENTION.

9. Each INVENTOR also covenants that he or she has not encumbered his or her right, title and interest in the INVENTION or APPLICATION, and has not, and will not, sign any document that conflicts with this assignment, other than the exception listed in paragraph 8 and has not, and will not, sign any document that conflicts with this assignment, except for documents necessary to memorialize or protect the rights of the U.S. Government (if any) in the INVENTION and APPLICATION.

Harold Kohn
INVENTOR's Signature
Harold Kohn

May 19, 1997
Date

Typed Name of INVENTOR

Address
4102 Aberdeen Way
Houston, TX 77025

STATE OF TEXAS)
COUNTY OF HARRIS) ss.

On this 19th day of MAY, 19 97, personally appeared the above-named, personally known to me and known by me to be the one who executed the foregoing instrument, and subscribed the same in my presence, and acknowledged the same to be a free act and deed, before me.

Diana Sue Kowis
Notary Public

My Commission expires:

